

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

ASTELLAS INSTITUTE FOR REGENERATIVE
MEDICINE,

Plaintiff,

v.

IMSTEM BIOTECHNOLOGY, INC., XIAOFANG
WANG, and REN-HE XU,

Defendants.

C.A. NO. 1:17-cv-12239-ADB

FACTS ESTABLISHED BY THE PARTIES' STIPULATION

Plaintiff Astellas Institute for Regenerative Medicine (“Astellas”) and Defendants Xiaofang Wang, Ren-He Xu, and ImStem Biotechnology, Inc. (collectively “Defendants” or “ImStem”) hereby submit the below stipulated facts as part of their respective pretrial memoranda.

1. Plaintiff Astellas Institute for Regenerative Medicine (“Astellas”) is a corporation organized and existing under the laws of Delaware with its corporate headquarters at 1 Astellas Way, Northbrook, IL 60062, and its principal place of business at 33 Locke Drive, Marlborough, MA 01752.

2. Plaintiff Astellas is the successor in interest to Advanced Cell Technology, Inc., Ocata Therapeutics, Inc., and Stem Cell & Regenerative Medicine International, Inc. (“SCRMI”).

3. Plaintiff Astellas is the current owner and assignee of U.S. Patent No. 8,962,321 (“the ’321 patent”).

4. The ’321 patent issued on February 24, 2015, is titled “Mesenchymal Stromal Cells And Uses Related Thereto,” and currently lists Erin Anne Kimbrel, Robert Lanza, Jianlin Chu, and Nicholas Arthur Kouris as inventors.

5. The application that issued as the ’321 patent was filed on November 30, 2012.

6. The ’321 patent claims priority to U.S. Provisional Application No. 61/565,358, which was filed on November 30, 2011.

7. The application that issued as the ’321 patent was published as U.S. Patent Application Publication No. US2013/0183272 on July 18, 2013.

8. Plaintiff Astellas is the current owner and assignee of U.S. Patent No. 8,961,956 (“the ’956 patent”).

9. The '956 patent issued on February 24, 2015, is titled "Mesenchymal Stromal Cells And Uses Related Thereto," and currently lists Erin Anne Kimbrel, Robert Lanza, Jianlin Chu, and Nicholas Arthur Kouris as inventors.

10. The application that issued as the '956 patent was filed on May 30, 2013, as a continuation-in-part of the application that issued as U.S. Patent No. 8,962,321.

11. The '956 patent claims priority to U.S. Provisional Application No. 61/565,358, which was filed on November 30, 2011.

12. The application that issued as the '956 patent was published as U.S. Patent Application Publication No. US2014/0072537 on March 13, 2014.

13. Plaintiff Astellas is the current owner of U.S. Provisional Application No. 61/565,358 ("the '358 provisional").

14. The '358 provisional was filed on November 30, 2011.

15. Plaintiff Astellas is the current owner of PCT Application No. PCT/US2012/0067464 ("the '464 PCT application"), which was filed on November 30, 2012 and published as WO2013/082543 on June 6, 2013.

16. PCT Application No. PCT/US2012/0067464 ("the '464 PCT application") claims priority to the '358 provisional.

17. Defendant ImStem Biotechnology, Inc. ("ImStem") is a corporation organized and existing under the laws of Connecticut with a principal place of business at 400 Farmington Ave, R1808, Farmington, CT 06030.

18. Defendant Wang and Michael Men work at Defendant ImStem.

19. Michael Men is the Acting Chief Executive Officer of Defendant ImStem.

20. Defendant Dr. Xiaofang Wang is the Chief Technical Officer, Director, and Vice President of Defendant ImStem, as well as one its founders. Previously, he was a post-doc in Defendant Dr. Ren-He Xu's lab and was a researcher at UConn Health Center.

21. Defendant Dr. Ren-He Xu was the Chief Scientific Officer of Defendant ImStem as well as one of Defendant ImStem's founders. He is currently on the Scientific Advisory Board of Defendant ImStem and a Professor and Associate Dean at the University of Macau. Before moving to Macau (where he currently lives), Dr. Xu was an Associate Professor at the UConn Health Center, as well as Director of its Stem Cell Institute.

22. Defendant Wang currently holds shares of Defendant ImStem.

23. Defendant Xu currently holds shares of Defendant ImStem.

24. Defendant ImStem currently owns U.S. Patent No. 9,745,551 ("the '551 patent").

25. The '551 patent is currently assigned to Defendant ImStem.

26. The '551 patent issued on August 29, 2017 and is titled "Mesenchymal-like Stem Cells Derived From Human Embryonic Stem Cells, Methods And Uses Thereof."

27. The '551 patent currently lists Xiaofang Wang and Ren-He Xu as inventors.

28. Defendants filed the U.S. application that issued as the '551 patent as a national stage entry of PCT Application No. PCT/US2013/048291.

29. The '551 patent claims priority to U.S. Provisional Patent Application Nos. 61/670,787 ("the '787 provisional") and 61/762,961 ("the '961 provisional"), which were filed on July 12, 2012 and February 11, 2013, respectively.

30. The application that issued as the '551 patent was published as U.S. Patent Application Publication No. US2015/0203820 on July 23, 2015.

31. Defendant ImStem currently owns the '787 provisional.

32. Defendants Wang and Xu filed the '787 provisional on July 12, 2012.

33. Defendant ImStem currently owns the '961 provisional.

34. Defendants Wang and Xu filed the '961 provisional on February 11, 2013.

35. Defendants filed PCT Application No. PCT/US2013/048291 on June 27, 2013, which published as WO2014/011407 on January 16, 2014.

36. On February 4, 2014, Astellas became aware of PCT Publication WO2014/011407. On February 21, 2014, Mary Lee Fleishell emailed a copy of WO2014/011407 to Dr. Kimbrel, Stacey L. Channing Esq. and Matthew Vincent and Erin Kimbrel emailed a copy to John Lu.

37. On September 12, 2019, Astellas and Defendants stipulated that “any final judgment of the Court with respect to Plaintiffs’ Count I (Correction of Inventorship for the '551 Patent: Drs. Kimbrel and Lanza as Sole Joint Inventors) and Count II (In the Alternative, Correction of Inventorship for the '551 Patent: Drs. Kimbrel and Lanza as Joint Inventors with the Currently Named Inventors) will apply with equal force to the patent issued from the '473 application.” (Dkt. 95.)

38. On February 11, 2020, the '473 application issued as U.S. Patent No. 10,557,122 (“the '122 patent”).

39. Defendants Wang and Xu formed Defendant ImStem in or about June 2012.

40. Plaintiff Astellas possessed certain technology related to generating mesenchymal stem cells and they shared that information with Defendants Xu and Wang for the purposes of a collaboration.

41. Dr. Wang emailed copies of Astellas’ U.S. Provisional Patent Application No. 61/565,358 and PCT Application No. PCT/US2012/067464 to an ImStem employee, Adam Lazorchek, on June 21, 2013.

42. Defendants represent that they are not commercializing the HB-MSC technology and are instead working to commercialize their “T-MSC” technology.

Dated: August 10, 2020

Respectfully submitted,

/s/ David P. Frazier

Charles H. Sanders (BBO# 646740)
LATHAM & WATKINS LLP
John Hancock Tower, 27th Floor
200 Clarendon Street
Boston, MA 02116
Telephone: (617) 948-6022
Facsimile: (617) 948-6001
charles.sanders@lw.com

Michael A. Morin (*pro hac vice*)
David P. Frazier (*pro hac vice*)
Rebecca L. Rabenstein (*pro hac vice*)
LATHAM & WATKINS LLP
555 Eleventh Street, NW, Suite 1000
Washington, DC 20004
Telephone: (202) 637-2200
Facsimile: (202) 637-2201
michael.morin@lw.com
david.frazier@lw.com
rebecca.rabenstein@lw.com

Lauren K. Sharkey (*pro hac vice*)
Brenda L. Danek (*pro hac vice*)
LATHAM & WATKINS LLP
330 North Wabash Avenue, Suite 2800
Chicago, IL 60611
Telephone: (312) 876-7700
Facsimile: (312) 993-9767
lauren.sharkey@lw.com
brenda.danek@lw.com

Yi Sun (*pro hac vice*)
LATHAM & WATKINS LLP
12670 High Bluff Drive
San Diego, CA 92130
Telephone: (858) 523-5400
Facsimile: (858) 523-5450
yi.sun@lw.com
*Counsel for Plaintiff Astellas Institute for
Regenerative Medicine*

Respectfully submitted,

/s/ Timothy R. Shannon

Timothy R. Shannon, MA Bar # 655325
Martha C. Gaythwaite, MA Bar # 187650
VERRILL DANA LLP
One Portland Square
Portland, Maine 04101
(207) 774-4000
tshannon@verrill-law.com
mgaythwaite@verrill-law.com

Benjamin M. Stern, MA Bar # 646778
VERRILL DANA LLP
One Federal Street, 20th Floor
Boston, Massachusetts 02110
(617) 309-2600
bstern@verrill-law.com

*Counsel for Defendants ImStem
Biotechnology, Inc., Ren-He Xu, and
Xiaofang Wang*